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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/211,507	12/14/1998	ALAN R. HIRSCH	054012-0009	9827

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT	PAPER NUMBER
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1654

36

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/211,507

Applicant(s)

HIRSCH, ALAN R.

Examiner

Christopher R. Tate

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,9-11,35 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9-11,35 and 39-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

The following is a non-final Office action following the decision by the Board of Appeals.

Claims 1, 2, 4-6, 9-11, 35, and 39-44 have been examined on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rendered vague and indefinite by the phrase "decismel units". It is unclear as to what this phrase means - e.g., this unit of measure does not appear to be recognized in the odorant/aroma art, and there does not appear to be a reasonable definition of what this phrase means with respect to an actual unit of measure. Is this attempting to define a measurement involving smell receptor units and/or olfactory concentration levels and if so, how is it actually measured? It is requested that Applicant particular point to a definition of this phrase within the instant specification, or provide objective evidence as to its meaning - e.g., within the odorant/aroma art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 2, 4-6, 9-10, 35, and 41, 43, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by the International Product Alert bulletin entitled "Poan Washable Cold Cream Manufacturer: Kurobara Honpo Category: Beauty Skin Care" (01 June 1994 - PROMT Abstract), or by McMath from Adweek's Marketing Week entitled "The Skin Trade Goes Natural" (27 August 1990 - PROMT Abstract).

A method of altering blood flow to the vagina of a female individual via administering by inhalation an odorant selected from a mixture of licorice-based and banana-nut odorants, a mixture of licorice-based and cucumber odorants, a mixture of lavender and pumpkin pie odorants, and a mixture of baby powder and chocolate odorants is claimed.

Each of the cited references teach topically applied skin creams comprising cucumber and licorice extracts (odorants) therein (see PROMT abstracts). The extract odorants within the cited commercial cream products would inherently and necessarily be inhaled by individuals using these commercial products including female individuals (please note that it is well accepted in the art that a vast majority of persons using such skin cream products are female individuals). In addition, the cited products would inherently provide a suprathreshold but not irritant amount of the inhaled extract odors (i.e., based upon the definition provided on page 5, lines 8-19, of the instant specification, the natural cucumber and licorice extract odors within the cited commercial skin creams would inherently be within a level detectable by a normosmic individual but not at a level so high or intense that it would be perceived as noxious or painful - thus, also within the claimed decismel level, as best understood). Further, please note that the functional effects instantly claimed would be inherent to the reference odorant-containing products upon inhalation, including their ability to increase or decrease blood flow to the vagina

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since, as readily admitted by Applicant, women's response to odors are not homogenous and women respond differently depending on their preferences of sexual activities and behaviors; and further, odorant mixtures including, e.g., licorice-based and cucumber odorants had the effect of increasing blood flow to the vagina in some women and decreasing blood flow to the vagina in other women (see, e.g., page 16, line 23 - page 17, line 27 of the instant specification). The cited skin cream products would inherently and necessarily be provided to consumers within an appropriate dispensable commercial container such as a pump jar, can, bottle, and/or other vessel having a cap.

Therefore, each of the cited references is deemed to anticipate the instantly claimed invention.

Claims 1, 2, 4, 5, 9, 10, 11, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by a female individual inhaling a mixture of scents (odorants) provided by the candle products on display within a Yankee Candle Co. store (as evidence, see attached website information pertaining to the candle products sold by this franchise chain within its stores - please note that the Yankee Candle Co. has been in business since 1969 and its products sold in franchise stores within malls since 1989).

The claims, as drafted, are deemed anticipated by a female customer entering a Yankee Candle Co. store (prior to Applicant's provisional filing date) and inhaling the scented candle fragrances (odorants) therein (including a female customer stopping in for a short period of time - e.g., about 1-3 minutes) because the odorants instantly claimed (e.g., pumpkin pie, lavender, banana nut bread, chocolate, etc) are provided as fragrances within the openly displayed candle products sold by this store chain (as evidence - see attached website product information).

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Accordingly, mixtures of such odorants (including one or more of the odorant mixtures instantly claimed) would inherently be inhaled by female customers within these stores. For the reasons discussed in the initial USC 102 rejection above, the claimed functional effects would also be inherent upon inhalation by a female individual within a Yankee Candle Co. store.

Therefore, a female individual inhaling a mixture of scents (odorants) such as those within the candle products (and as instantly claimed) on display within a Yankee Candle Co. store is deemed to anticipate the cited claims for the reasons set forth above.

Please note that limiting the cited independent claims so as to provide such odorant mixtures within certain types of claimed delivery devices and/or containers - i.e., blister pack, scratch-and-sniff odor patch, scented cloth, aerosol spray, pump-type spray, nasal spray - would overcome the art rejection immediately above (concerning the Yankee Candle Co.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 9-11, 35, and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the International Product Alert bulletin entitled "Poan Washable Cold Cream Manufacturer: Kurobara Honpo Category: Beauty Skin Care" (01 June 1994 - PROMT Abstract), and McMath from Adweek's Marketing Week entitled "The Skin Trade Goes Natural" (27 August 1990 - PROMT Abstract).

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The references are relied upon for the reasons discussed *supra*.

Based upon the beneficial teachings provided by the cited references with respect to the commercial skin care products disclosed therein, it would have been obvious to one of ordinary skill in the art at the time to claimed invention was made to provide such female-oriented commercial skin cream products within one or more conventional, easy-to-use dispensable containers/vessels (such as those claimed) commonly employed within the skin care cosmetic art. In addition, it would have been obvious for a female individual to apply such skin cream products (and thus inhale the natural cucumber and licorice extract odorants contained therein) for the amount of time instantly claimed (e.g., 1-3 minutes) as this time range is considered a typical, customary time period for such topical application.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher R. Tate
Primary Examiner
Art Unit 1654



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